

REMARKS

This Amendment is submitted in response to the Office Action dated January 21, 2005. In the Office Action, the Patent Office rejected Claims 1-5 and 7 under 35 U.S.C. §103(a) as being unpatentable over *Song* (U.S. Patent No.: 5,617,751) in view of *Callahan* (U.S. Patent No.: 4,235,459). Further, the Patent Office rejected Claims 9-19 under 35 U.S.C. §103(a) as being unpatentable over *Song* in view of *Miller* (U.S. Patent No.: 6,244,763). Finally, the Patent Office rejected Claims 6 and 8 under 35 U.S.C. §103(a) as being unpatentable over *Song* in view of *Miller*.

The Patent Office rejected Claims 1-5 and 7 under 35 U.S.C. §103(a) as being unpatentable over *Song* in view of *Callahan*. The Patent Office alleges that the *Song* discloses a key tag, as shown in Figures 5a-6b, that is comprised of a plastic or metal tag having a first side and a second side, both defined as Part #50, as described in lines 20-21 of Column 5, where said first side and said second side are indented, and are both capable of accommodating a label. The Patent Office alleges that the label is secured to the first or second side by means of an adhesive and an opening, defined by Part 62 is located between said first side and said second side for accommodating a key ring.

The Patent Office alleges that *Song* as set forth above, discloses all of the features claimed except for the use of a pre-formed label card with a plurality of removable labels, and a key tag with a second opening for accommodating a key ring. The Patent Office states that *Callahan* discloses a marking system, as shown in Figures 1-4 that is comprised of a pre-formed label sheet or card, with a plurality of labels provided thereon, said labels being provided as a system for marking objects such as keys, where said labels are affixed

to an object by means of an adhesive. The use of a key tag with a plurality of openings for attaching a plurality of key rings to said key tag would be considered by one of ordinary skill in the art to be an obvious multiplication of parts for the purpose of providing attachment means for a plurality of key rings instead of a single key ring.

Moreover, the Patent Office alleges that the use of a key tag having an opening and a first and second side that are fabricated in a single piece construction instead of from a plurality of parts would be considered by one of ordinary skill in the art to be an obvious reduction of parts for the purpose of facilitating the assembly of the key tag.

Song illustrates a key fob including at least one dome with a display surface and a flange secured in a fob. The fob is sewn in a pattern around or through the flange or openings therethrough. The fob may also be formed by placing display domes within an outer rim and sealing the combination within a u-shaped ring. Designs and slogans may be placed on the display surfaces. The fob may then be attached to a key ring using a clip configured to accommodate crimping. The clip attachment allows the fob to rotate freely around the key ring.

Song further specifies that:

“According to another embodiment, the key fob has two thin display inserts placed between two transparent display domes, all of which are seated in a rim. The thin display inserts may be easily replaced and may exhibit pictures, novelty marks, advertising slogans, or the like through the transparent display domes. The pieces are secured together within the rim by a U-

shaped ring which fits over the rim assembly. The pieces may be prevented from rotating within the rim by including a notch in each of the pieces and corresponding dimples on the rim. Fabrication is thus simplified while allowing an easily customized fob, which may be customized by the individual user.”

Of significant importance in the *Song* patent, is the essence of fabrication that includes a plurality of pieces that can be customized and interchanged. The display inserts (2) may be inserted under transparent domes and ultimately connected to the U-shaped ring which fits over the rim assembly. However, to be customized and interchangeable, it becomes necessary to have a plurality of parts as required by the *Song* patent, and not a single piece construction as required by the present invention.

Callahan discloses a marking system wherein distinctive, adhesive backed separable markers are carried on a substrate, and printed on the substrate are images of the respective markers with a blank line being printed adjacent each image on which objects marked may be recorded. The system is particularly, though not exclusively, suited to the marking of keys.

Previously amended Claim 1 requires an apparatus for labeling key tags. The apparatus has a key tag having a first side and a second side wherein the first side and the second side accommodate a label thereto. Moreover amended Claim 1 requires an opening between the first side and the second side wherein the opening accommodates a key ring wherein said opening and said first side and said second

side of said key tag are fabricated in a single piece construction; and a pre-formatted label card wherein the label card has a plurality of labels contained thereon wherein the labels may be affixed to either of the first side or the second side of the tag.

However, neither *Song* or *Callahan*, taken singly or in combination teach or suggest a key tag having an opening between the first side and the second side wherein the opening accommodates a key ring wherein said opening and said first side and said second side of said key tag are fabricated in a single piece construction; and a pre-formatted label card wherein the label card has a plurality of labels contained thereon wherein the labels may be affixed to either of the first side or the second side of the tag as required by Claim 1. More specifically, *Song* does not teach or suggest a key tag having a first side and a second side wherein said key tag is fabricated in a single piece construction. On the contrary, *Song* teaches a plurality of pieces that are connected together to create a key fob wherein the object of the patent is to fabricate easily customized fobs, which may be customized by the individual user. Moreover, *Song* requires a fob that has one thin display insert displayed through a transparent display dome. The display insert is sandwiched between the display dome and an opaque dome. The pieces of the fob are secured together by a U-shaped ring. Other embodiments include any combination of opaque domes and clear domes. However, essential to the *Song* patent is the interchangeability and customization of the different pieces of the fob for individual

use. Nowhere in *Song* is it disclosed the use of a single two sided key tag fabricated in a single piece construction.

Further, the Patent Office provided no teaching as to why one having ordinary skill in the art would have been led to modify *Song* in combination with *Callahan* to create Applicant's invention. Since the Patent Office failed to establish a *prima facie* case of obviousness, the rejection of Claims 1-5 and 7 under 35 U.S.C. §103(a) has been overcome. Notice to that effect is requested.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicants' invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing remarks and amendments, the rejection of Claims 1-5, and 7 over *Song* in view of *Callahan* under 35 U.S.C. §103(a) have been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the Patent Office rejection of Claims 9-19 under 35 U.S.C. §103(a) as being unpatentable over *Song* in view of *Miller*, Applicant respectfully submits that the rejection has been overcome by the previous amendment to the independent Claim 9 and for the reasons below.

Amended Claim 9 requires a key tag labeling system having a key tag having a first opening to accommodate a key ring and a surface to accommodate a label wherein the key tag has a first opening and a surface to accommodate a label that are a single edifice. Moreover, Claim 9 requires a label having a first side and a second side wherein the first side is adhesively secured to the key label and further wherein the second side of the label is printable thereon. Further Claim 9 requires a downloadable program for label preparation.

As previously stated, *Song* illustrates a key fob including at least one dome with a display surface and a flange secured in a fob. The fob is sewn in a pattern around or through the flange or openings therethrough. The fob may also be formed by placing display domes within an outer rim and sealing the combination within a u-shaped ring. Designs and slogans may be placed on the display surfaces. The fob may then be attached to a key ring using a clip configured to accommodate crimping. The clip attachment allows the fob to rotate freely around the key ring. As previously illustrated,

Song's key fob alleges that "fabrication is simplified to these interlocking domes that are placed about a U-shaped ring which allows for interchangeability and customization of the key fob.

Miller teaches a sheet having at least one self adhesive special purpose label arrangement set having a postage indicia label, and addressee label and a sender label, wherein the maximum printable area of the sheet is made available for the labels, and a process for printing these special purpose label arrangement sets. In the process, a computer system with a printer is used to prepare and print the label relating to the address, the sender and the mail piece to be mailed.

Miller does not teach or suggest a labeling system for application to a key tag. On the contrary, the *Miller* patent specifically discloses a label system for mail pieces and accessories. Moreover, *Song* does not teach or suggest a key tag labeling system having a key tag having a first opening to accommodate a key ring and a surface to accommodate a label wherein the key tag has a first opening and a surface to accommodate a label that are a single edifice as required by Claim 9.

Further, the Patent Office provided no teaching as to why one having ordinary skill in the art would have been led to combine the teachings of *Song* with the unrelated art of *Miller* to create Applicant's invention. Since the Patent Office failed to establish a *prima facie* case of obviousness, the rejection of Claims 9-19 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicants' invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing remarks and amendments, the rejection of Claims 9-19 over *Song* in view of *Miller* under 35 U.S.C. §103(a) have been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 6 and 8 under 35 U.S.C. §103(a) as being unpatentable over *Song* in view of *Callahan*, Applicant respectfully submits that the rejection has been overcome by the previous amendment to Claim 1, for which Claim 6 and Claim 8 depend. Notice to that effect is requested.

Claims 2-8 depend from Claim 1; Claims 10-14 depend from Claim 9; and Claims 16-19 depend from Claim 15. These claims are further believed allowable over *Song*,

Callahan and Miller, taken singly or in combination, for the same reasons set forth with respect to independent Claims 1, 9 and 15 since each sets forth additional novel components and steps of Applicant's key tag and system.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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Hamir Z. Sayed
Gordon & Rees LLP
101 W. Broadway Suite 1600
San Diego, CA 92101
(619) 696-6700 (office)
(619) 230-7474 (direct)
hsayed@gordonrees.com
ATTORNEY FOR APPLICANT

CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as Express Mail in an envelope addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 16, 2005.


Mimi Beuchat